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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,461	03/07/2001	Lydia Breck	40655.0700	3738

7590 08/09/2004

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EXAMINER

WINTER, JOHN M

ART UNIT PAPER NUMBER

3621

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,461

Applicant(s)

BRECK ET AL.

Examiner

John M Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-19, 22-25, 31-33, 36, 38-45, 51, 55 and 56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-25, 31-33, 36, 38-45, 51, 55 and 56 is/are allowed.
- 6) ☒ Claim(s) 17 is/are rejected.
- 7) ☒ Claim(s) 18 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Election/Restrictions

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 17-19,22,23-25, 31-33, 36, 38-45,51,55 and 56 drawn to conducting secure transactions, classified in class 705 subclass 64.
 - II. Claims 46-49, drawn to non currency transactions, classified in class 705 subclass 37.
 - III. Claim 52, drawn to dispute resolution, classified in class 705 subclass 1.

Inventions I, II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the limitations of invention I do not require dispute resolution or a non-currency transaction in order to be implemented. The subcombination has separate utility such as dispute resolution and conducting a non currency transaction.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Examiner notes that it would be a burden to search multiple inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Via the paper filed on June 7, 2004 the applicant has elected the examination of invention I directed towards claims 17-19,22,23-25, 31-33, 36, 38-45,51,55 and 56. Affirmation of this election must be made by applicant in replying to this Office action. Claims 46-49 and 52 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 17-19,22,23-25, 31-33, 36, 38-45,51,55 and 56 have been examined

Response to Arguments

The Applicants arguments filed on June 7, 2004 have been fully considered.

The Examiner states that the feature of usage parameters associated with secondary transaction numbers is disclosed by the newly discovered reference Teicher (US Patent 6,065,675). See following rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US Patent 6,163,771) in view of Franklin et al (US Patent 5,883,810) and further in view of Teicher (US Patent 6,065,675).

As per claim 1,

Walker ('771) discloses a transaction, comprising the steps of:

identifying at least one primary account;(Column 6, lines 54-59)

generating a secondary transaction number that is configured to facilitate a transaction;(Column 6, lines 29-38)

associating the secondary transaction number with said at least one primary account;(Column 6, lines 46-49)

issuing the secondary transaction number to a first party to facilitate a transaction with a second party,(Column 6, lines 30-38)

Walker ('771) does not explicitly disclose the secondary transaction number is configured to be immediately usable for facilitating the transaction. Franklin et al. ('810) discloses the secondary transaction number is configured to be immediately usable for facilitating the transaction.(Figure 3) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Walker et al. method with the Franklin et al. method in order to promote secure online commerce.

Walker ('771) does not explicitly disclose "allowing the first party to select and define conditions of use parameters, wherein the parameters place limits on how the secondary transaction number may be used; and associating the conditions-of use parameters with the secondary transaction number. Teicher ('675) discloses allowing the first party to select and define conditions of use parameters, wherein the parameters place limits on how the secondary transaction number may be used; (column 3, lines 46-67) and associating the conditions-of use parameters with the secondary transaction number.(Figure 1) It would be obvious to one having

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ordinary skill in the art at the time the invention was made to combine the Walker et al. method with the Teicher method in order to promote secure online commerce.

Allowable Subject Matter

Claims 22,23-25, 31-33, 36, 38-45,51,55 and 56 are allowable

Claims 18-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

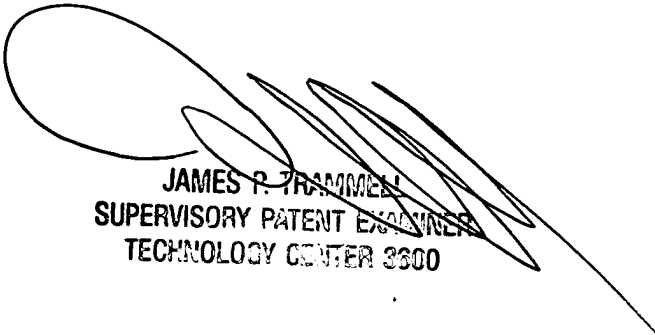
Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW
July 27, 2004



JAMES P. TRAMMELL
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